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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,656	10/24/2003	Igor Dozmorov	OMRF:013US	9649
7590 12/27/2007				
Michael C. Barrett, Esq. FULBRIGHT & JAWORSKI, L.L.P. Suite 2400 600 Congress Avenue Austin, TX 78701				
			EXAMINER	
			SKOWRONEK, KARLHEINZ R	
			ART UNIT	PAPER NUMBER
			1631	
			MAIL DATE	DELIVERY MODE
			12/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/693,656	Applicant(s) DOZMOROV ET AL.	
	Examiner Karlheinz R. Skowronek	Art Unit 1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The examiner of record has changed. Please direct all further correspondence to Karlheinz R. Skowronek whose telephone number is (571) 272-9047.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 September 2007 has been entered.

Claim Status

Claims 1, 3-9, 11-13 are pending.

Claims 2 and 10 are cancelled.

Claims 1, 3-9, 11-13 are being examined.

Specification

The disclosure is objected to because of the following informalities:

Page 14 of the specification refers to table 1a-1d of the appendix. Table 1

and the appendix were not in the disclosure as originally filed.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

Response to Arguments

Applicant's arguments, see remarks p. 7, filed 26 September 2007, with respect to the rejection of claims 1, 3-9, and 11-13 as non-statutory subject matter under 35 USC 101 have been fully considered and are persuasive. The rejection of claims 1, 3-9, and 11-13 has been withdrawn based on the amendment of the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-9, and 11-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The claims are directed to a method of analyzing expression profile data using a paired T-test and modified form of the T-test to determine differentially expressed genes and outputting to a display. The specification describes throughout, the determination process. The specification does not disclose the outputting to a display. The specification does support displaying the classified true positives in a list, as described on p. 14, line 6-10.

Claims 1, 3-9, and 11-13 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The claims recite "a result", which is new matter, in claim 1 at the last line. The specification does not support this limitation. The specification does provide support for displaying only the classified true positives as in table 2, page 15. The specification does not support displaying the classified false positives, classified potential positives or the combination of classified false positives, classified potential positives and classified true positives.

Both new matter rejections above could be overcome by amendment that incorporates language such as "displaying the classified true positives" or "outputting the classified true positives to a user".

Response to Arguments

Applicant's arguments filed 26 September 2007 have been fully considered but they are not persuasive. Applicant argues that figure 4 and the brief description of figure 4 disclose support for the limitation of outputting a result to a display. Neither figure 4 nor the description of figure 4, describe a step of outputting the result to a display. Furthermore, figure 4 fails to show potential positives.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karlheinz R. Skowronek whose telephone number is (571) 272-9047. The examiner can normally be reached on Mon-Fri 8:00am-5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie A. Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

20 December 2007

/KRS/
Karlheinz R. Skowronek
Assistant Examiner, Art Unit 1631

/John S. Brusca/
Primary Examiner
Art Unit 1631